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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/740,263

12/18/2000

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40581 7590 12/28/2012
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EXAMINER

HOSSAIN, FARZANA E

ART UNIT

PAPER NUMBER

2424

NOTIFICATION DATE

DELIVERY MODE

12/28/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KEITH BARRACLOUGH, BRYAN R. MARTIN,
PHILIP BEDNARZ, and PAUL VOOIS

Appeal 2010-011033
Application 09/740,263
Technology Center 2400

Before JOSEPH F. RUGGIERO, MARC S. HOFF, and
STANLEY M. WEINBERG, *Administrative Patent Judges*.

WEINBERG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-75. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Claims 3 and 5 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.¹

Claims 1, 2, 4, 6, 8-16, 21, 23-28, 30, 32-36, 42-49, 51, 53-59, 63-66, 68, 70, and 74 stand rejected under 35 U.S.C. § 103(a) as obvious over Hamlin (US 5,574,964; Nov. 12, 1996) in view of Ellis (US 2005/0251827 A1; Nov. 10, 2005).

Claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) as obvious over Hamlin in view of Ellis and further in view of Edson (US 6,526,581 B1; Feb. 25, 2003).

Claims 7, 22, 29, 31, 37-41, 67, and 75 stand rejected under 35 U.S.C. § 103(a) as obvious over Hamlin in view of Ellis and further in view of Edens (US 6,611,537 B1; Aug. 26, 2003).

Claims 17-19, 52, and 60-62 stand rejected under 35 U.S.C. § 103(a) as obvious over Hamlin in view of Ellis and further in view of Cohen (US 4,837,798; June 6, 1989).

Claims 20 and 50 stand rejected under 35 U.S.C. § 103(a) as obvious over Hamlin in view of Ellis and further in view of Goldstein (US 5,410,326; Apr. 25, 1995).²

¹ Throughout this opinion, we refer to (1) the Appeal Brief filed December 29, 2009; (2) the Examiner's Answer mailed March 29, 2010; and (3) the Reply Brief filed June 1, 2010.

² Although Appellants' Statement of Related Appeals and Interferences (App. Br. 2) and their Appendix of Related Proceedings (App. Br. 37) states they are "unaware of any related appeals" "apart from the file history of the instant application" and although Appellants mentioned "the September, 2008 BPAI Decision referenced at page 5 of the Office Action" in the argument section of their Appeal Brief (App. Br. 12), we observe that this Board did render an earlier opinion in this application on September 30, 2008, which Appellants did not clearly and definitively bring to the Board's

Claims 69 and 71-73 stand rejected under 35 U.S.C. § 103(a) as obvious over Hamlin in view of Ellis and further in view of Lewis (US 5,835,126; Nov. 10, 1998).

STATEMENT OF THE CASE

Appellants' invention relates generally to interfacing external service-provider networks (e.g., cable, Internet, and telephone providers) and a target facility such as a residence having multiple appliances (e.g., telephone, TV, computer). A Network Interface Unit (NIU) couples the external services data over a bussing arrangement to the appliances. Spec. 1:12-15; 4:10-12; 10:5; Figs. 1, 2.

Independent claim 1 is illustrative with key disputed limitations emphasized:

1. A closed-loop media storage and playback circuit arrangement for processing media-based external-services data for a user facility that provides media and telephony-related services to its users, the arrangement comprising:
 - a closed-loop audio, video, and data signal bussing arrangement adapted to distribute audio, video, and data to designated points in the user facility;
 - a plurality of telephony-based appliances communicatively coupled to the bussing arrangement, wherein the plurality of appliances provide bi-directional telephony services using at least one of: audio, video, and data signals;*
 - a media storage and playback device including
 - at least one data memory circuit adapted to store external-services data and adapted to store configuration data and,

attention as required by its Rules, even though the previous appeal involved the same prior art that is involved in the present appeal. We thank the Examiner for bringing to our attention the Board's previous decision in this application. Ans. 2, 55.

a programmable network interface unit (NIU) adapted to store media-based external-services data in the memory circuit and to communicatively couple the stored external services data from the memory circuit to the plurality of appliances in the user facility via the bussing arrangement as a function of the configuration data in the memory circuit; and

a remote-control user input device adapted to communicate with the NIU, in response to user inputs received at the remote user input device, to

access the data stored in the memory circuit,
program the programmable NIU by providing the configuration data to the NIU, and

command the NIU by communicating command signals via the closed-loop bussing arrangement to configure the external-services data for use at a particular one of the plurality of appliances in the user facility, based upon capabilities of the particular one of the appliances, and to control the NIU to communicate the configured external-services data to the particular one of the plurality of appliances.

THE SECTION 112, FIRST PARAGRAPH,
WRITTEN DESCRIPTION REJECTION

Claims 3 and 5

The Examiner rejects claims 3 and 5 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Regarding claim 3, the Examiner does not dispute Appellants' reference to parts of the Specification that support claim 3 (*compare* App. Br. 19 *with* Ans. 54), but concludes that Appellants' Specification does not describe performing a non-frequency-based reconfiguration of external services data because, in the Examiner's view, "there *may* still be frequency-based conversion taking place without explicit disclosure stating that it is not taking place." Ans. 54 (emphasis added).

Regarding claim 5, the Examiner does not dispute Appellants' reference to parts of the Specification that support claim 5 (*compare* App. Br. 19-20 *with* Ans. 54-55); but concludes that Appellants' Specification does not describe communicating data in a packetized format including a packet header because "[t]he system *could* just as easily work by converting the Internet data to a format not containing a packet header prior to sending the data over the coaxial network." Ans. 55 (emphasis added).

To satisfy the written description requirement, the disclosure must reasonably convey to skilled artisans that Appellants possessed the claimed invention as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). But, "[t]he claims do not run afoul of the written description requirement simply because it is possible to broadly interpret the claims in a way that is not described in the Specification." *Ex parte Moriguchi*, 2012 WL 1637675 at *3 (BPAI 2012) (citing cases decided by the U.S. Court of Customs and Patent Appeals).

In the present case, the Examiner has rejected claims 3 and 5 because Appellants' written description does not describe, or does not exclude, other possible embodiments.

We find that Appellants' disclosure reasonably conveys to skilled artisans that Appellants possessed the claimed invention as of the filing date.

We are persuaded that the Examiner erred in rejecting claims 3 and 5 as failing to comply with the written description requirement.

Accordingly, we will not sustain the Examiner's rejection of claims 3 and 5 under 35 U.S.C. § 112, first paragraph.

THE OBVIOUSNESS REJECTIONS ANALYSIS

As we noted above, all of the prior art rejections in this case are based on 35 U.S.C. § 103(a). In the middle of Appellants' Appeal Brief, after their discussion of the rejections of some claims (App. Br. 7-12) and before their discussion of the rejections of other claims (App. Br. 15-20), Appellants generally contend that the rejections of claims 1, 2, 4, 6, 8-16, 21, 23-28, 30, 32-36, 42-49, 51, 53-59, 63-66, 68, 70, and 74 are improper for a number of reasons: an improper assertion of an obvious to try argument (App. Br. 12:29); no record support to modify Hamlin (App. Br. 13:19-20); Hamlin teaches away from modifying data "as claimed" (App. Br. 13:24-25); end devices cannot process data configured into a different format (*id.*).

These arguments, and the other contentions in Section A(5) of Appellants' Appeal Brief, are not persuasive, because they are only generalized arguments without specific reference to claim language.

Appellants also generally contend that all of the § 103 rejections are improper because the cited references teach away from the Examiner's combination (App. Br. 14:5-6) and the proposed modification of Hamlin to reconfigure data would render Hamlin inoperable for its purpose (App. Br. 14:15-21).

Again, these arguments, and the other contentions in Section A(6) of Appellants' Appeal Brief, are not persuasive because they are only generalized arguments without specific reference to claim language. Moreover, as the Examiner correctly notes, the Board's 2008 decision in this case adopted the Examiner's conclusion that it would have been obvious to

modify Hamlin with Ellis for at least the reasons stated by the Examiner at that time. Ans. 45:12-14. *See* 2008 BPAI Decision 12-13.

Appellants' Reply Brief similarly presents many generalized arguments directed to "[t]he Examiner's [unspecified] grounds of rejection" (Reply Br. 4:4) without specifying claim language and without providing evidence in support of purported common or conventional usage, what a skilled artisan purportedly would have done, and purported plain meaning. Reply Br. 4-5. These arguments are similarly not persuasive.

THE OBVIOUSNESS REJECTION OVER HAMLIN AND ELLIS

The Examiner finds that Hamlin's interface pods 44 teach the claimed plurality of telephony-based appliances are communicatively coupled to a bussing arrangement 36 to provide bi-directional telephone services 56. Ans. 5; Figs. 1, 4.

Appellants contend that the pods are not end devices that actually *use* content from the external service providers. Instead, they contend, the pods are only network interface devices³ that *route* content. App. Br. 6:24-25; 7:9-11.

³ Appellants' reference to Hamlin's pods as "network interface devices" (*see, e.g.*, App. Br. 7:10) should not be confused with the claimed "network interface unit (NIU)" at, for example, claim 1, line 12, and Specification page 2, lines 4-5. The Examiner maps the claimed NIU to Hamlin's converter 34 (Ans. 6:5), which Appellants acknowledge. Reply Br. 3:17.

ISSUE

Under § 103, has the Examiner erred by finding that Hamlin's pods are appliances as recited in claim 1?

Clams 1, 6, 8-15, 21, 23-28, 30, 32-36, and 42-45

The Examiner finds that Hamlin's pods can be interpreted as the claimed appliances. Ans. 38:7-8. Appellants' arguments regarding claim 1 are not commensurate with the limitations of claim 1. Contrary to Appellants' contentions, claim 1 does not recite "an end device that actually uses the content" (App. Br. 7:11; *see also* App. Br. 8:1-2, 16-17; 9:3-5) or a device that is configured based on "capabilities of the end device" (App. Br. 8:3). Instead, claim 1 recites "appliances" without identifying the location or function of the appliances and recites "capabilities of . . . one of the appliances" rather than capabilities of an end device. Similarly, Appellants' contentions that Hamlin does not teach data configuration specific to an end device (App. Br. 9:8–10:7) or "device-specific frequency translation" (App. Br. 11:6) are also not commensurate with the claim language. In the absence of recitations that limit the locations or uses of the recited appliances, and giving the claim its broadest reasonable interpretation, we agree with the Examiner's mapping of Hamlin's pods to the recited appliances.

Although it is not clear whether *res judicata* can be applied to *ex parte* proceedings before the Board (*see In re Craig*, 411 F.2d 1333, 1336 (CCPA 1969)), we note that the Board's previous decision in this case agreed with the Examiner's finding that "Hamlin's routing telephone network data to *pods* and receiving units in the home, constitute 'a plurality of telephony-based *appliances* communicatively coupled to the bussing arrangement.'" 2008 Board Decision 12 (emphases added).

Alternatively, Appellants argue that the Examiner has incorrectly construed the term “capabilities” in claim 1 (Reply Br. 4-5) because the Examiner’s interpretation is purportedly contrary to the understanding of a skilled artisan and contrary to plain meaning. Reply Br. 4:6, 24-29; 5:7-8, 21-24. We find the Examiner’s claim construction to be reasonable. Appellants’ arguments are not persuasive because Appellants have not provided supporting evidence of the purported understanding of a skilled artisan or of the purported plain meaning.

We are therefore not persuaded that the Examiner erred in rejecting (1) representative claim 1; and (2) claims 6, 8-15, 21, 23-28, 30, 32-36, and 42-45 not argued separately with particularity.

Accordingly, we will sustain the Examiner’s rejections of claims 1, 6, 8-15, 21, 23-28, 30, 32-36, and 42-45.

Claims 2, 4, and 16

We have grouped these claims because they are grouped in Appellants’ Reply Brief. Reply Br. 6-7.

Appellants incorporate their arguments in Section A(1) of their Appeal Brief regarding pods not corresponding to end devices and in Section A(2) of their Appeal Brief regarding frequency translation. App. Br. 11-12. As stated above, we are not persuaded.

Claim 2 recites that the NIU changes external services data into a different processor-readable format. Claim 4 recites that the NIU configures external services data into a different communications format.

The Examiner finds that these limitations are met by Hamlin’s converter 34 (Figs. 1, 2) which performs protocol conversion and/or demodulation as necessary to produce signals in a common format, but at

different frequencies. Ans. 7-8 (citing Hamlin col. 3, ll. 27-37). *See also* Fig. 2. The Examiner also finds that common-bus network 36 is not a packet-switched network, but a frequency-based coaxial network. Ans. 42:21–43:1.

Claim 16 depends from claim 15, the latter reciting that “the NIU is adapted to convert” data in a first form into a second data form. Claim 16 defines the first data form as including packet-based data and the second data form as including non-packet-based data.

Hamlin teaches that some of the data inputted to converter 34 is from satellite dish 26. Hamlin, col. 2, ll. 64-65. Appellants agree that satellite television data is packet-based (App. Br. 11:21-22) and that Hamlin “communicate[s] frequency-converted signals in a non-packet-based format.” App. Br. 11:26-28. Appellants contend, however, that Hamlin does not *alter* data format from packet-based to non-packet-based (App. Br. 11:28–12:1).

The Examiner finds that Hamlin’s converter 34 is able to convert from mass media or internet signals to a signal that is communicated on bus 36. Ans. 11, 43. The Examiner also finds that Hamlin’s use of coaxial cable as bus 36 means that converter 34 converts data from one format to another format. Ans. 42-43. Appellants contend that the rejection *requires* the Board to find that packet-based communications cannot be sent over a coaxial cable or over a common bus. Reply Br. 6:4-5. We disagree because we find that Appellants have misconstrued the Examiner’s findings.

We conclude that the Examiner’s findings are reasonable. Although Appellants present a number of technical arguments as to why the Examiner is wrong (Reply Br. 6-7), none of the arguments are supported by evidence.

In addition, the “adapted to” language of claim 15 (from which claim 16 depends) does not require an actual conversion of data from one form to another form – only a system that is “adapted to” do so.

We are therefore not persuaded that the Examiner erred in rejecting claims 2, 4, and 16.

Accordingly, we will sustain the Examiner’s rejection of claims 2, 4, and 16.

Claims 46-49, 51, 53-59, 63-66, 68, 70, and 74

Although Appellants initially contend that Hamlin does not teach the limitations in these claims (App. Br. 8:5-6; 9:17-19; 10:8–11:2), we agree with the Examiner’s reasonable and unrefuted subsequent findings and responses. Ans. 39:22–40:16.

We are therefore not persuaded that the Examiner erred in rejecting (1) independent claims 46, 55, and 65; and (2) claims 47-49, 51, 53, 54, 56-59, 63, 64, 66, 68, 70, and 74 not separately argued with particularity.

Accordingly, we will sustain the Examiner’s rejection of claims 46-49, 51, 53-59, 63-66, 68, 70, and 74.

THE OBVIOUSNESS REJECTION
OVER HAMLIN, ELLIS, AND EDSON

Claims 3 and 5

Appellants incorporate the following arguments in their Appeal Brief: Section A(1) regarding pods not corresponding to end devices; Section A(2) regarding frequency translation; and Sections A(5) and A(6) regarding motivation, obvious to try, and teaching away. App. Br. 15. As stated above, we are not persuaded by these arguments.

Appellants contend that the Office Action from which this appeal is taken did not identify the Edson reference. App. Br. 15. However, the Examiner notes that Edson was identified on Form PTO-892 that accompanied the Office Action mailed on August 12, 2009. Ans. 46. Appellants do not contend otherwise.

Appellants' arguments in their Appeal Brief in opposition to the rejections of claims 3 and 5 are not persuasive because they only recite claim language. An argument that merely points out what a claim recites is unpersuasive. 37 C.F.R. § 41.37(c)(1)(vii). *Accord In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[T]he Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

Appellants' Reply Brief raises a number of arguments in opposition to the rejections of these claims. Reply Br. 7, 9. However, these arguments have been raised for the first time in the Reply Brief and are therefore waived. “[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner’s rejections, but were not.” *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative). “[A]n issue not raised by an appellant in its opening brief . . . is waived.” *Optivus Tech., Inc. v. Ion Beam Appl’ns S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (citations omitted) (internal quotations marks omitted).

We therefore are not persuaded that the Examiner erred in rejecting claims 3 and 5.

Accordingly, we will sustain the Examiner's rejection of claims 3 and 5.

THE OBVIOUSNESS REJECTION
OVER HAMLIN, ELLIS, AND EDENS

Claims 7, 22, 29, 31, 37-41, 67, and 75

Appellants incorporate the following arguments in their Appeal Brief: Section A(1) regarding pods not corresponding to end devices; Section A(2) regarding frequency translation; and Sections A(5) and A(6) regarding motivation, obvious to try, and teaching away. App. Br. 16. As stated above, we are not persuaded.

Although the Examiner provides detailed citations and explanations in support of the rejections of these claims (Ans. 27-31), Appellants provide a specific response only to the rejection of claim 22. For that claim, the Examiner finds that Edens teaches delivering configuration data in the form of caller ID to a system and provides a motivation to include caller ID in the Hamlin system: to allow for easy viewing of caller identification and integration/use with pre-existing systems. Ans. 28. Appellants do not respond to the Examiner's stated motivation for displaying caller ID information. Instead, they argue that the Examiner does not explain how Hamlin's bus would route calls. App. Br. 16:20-22. Appellants still do not refute the Examiner's stated motivation when the Examiner explains how Hamlin would route such telephone data over its communication bus 36. *Compare* Ans. 49-50 *with* Reply Br. 8-9.

We are therefore not persuaded that the Examiner erred in rejecting (1) claim 22 and (2) claims 7, 29, 31, 37-41, 67, and 75 not separately argued with particularity.

Accordingly, we will sustain the Examiner's rejection of claims 7, 22, 29, 31, 37-41, 67, and 75.

THE OBVIOUSNESS REJECTION
OVER HAMLIN, ELLIS, AND COHEN

Claims 17-19, 52, and 60-62

Appellants incorporate the following arguments in their Appeal Brief: Section A(1) regarding pods not corresponding to end devices; Section A(2) regarding frequency translation; and Sections A(5) and A(6) regarding motivation, obvious to try, and teaching away. App. Br. 16-17. As stated above, we are not persuaded.

The Examiner provides detailed reasons for the rejections of these claims. Ans. 32-34, 50-51.

Appellants' additional arguments are general and not directed to any specifically identified claims or claim language. App. Br. 17.

We are therefore not persuaded that the Examiner erred in rejecting claims 17-19, 52, and 60-62.

Accordingly, we will sustain the Examiner's rejection of claims 17-19, 52, and 60-62.

THE OBVIOUSNESS REJECTION
OVER HAMLIN, ELLIS, AND GOLDSTEIN

Claims 20 and 50

Appellants incorporate the following arguments in their Appeal Brief: Section A(1) regarding pods not corresponding to end devices; Section A(2) regarding frequency translation; and Sections A(5) and A(6) regarding motivation, obvious to try, and teaching away. App. Br. 17-18. As stated above, we are not persuaded.

The Examiner provides detailed reasons for the rejections of these claims. Ans. 34-35, 51-52.

Appellants' additional arguments are general and not specifically directed to either of claims 20 or 50. App. Br. 18.

We are therefore not persuaded that the Examiner erred in rejecting claims 20 and 50.

Accordingly, we will sustain the Examiner's rejection of claims 20 and 50.

THE OBVIOUSNESS REJECTION
OVER HAMLIN, ELLIS, AND LEWIS

Claims 69 and 71-73

Appellants incorporate the following arguments in their Appeal Brief: Section A(1) regarding pods not corresponding to end devices; Section A(2) regarding frequency translation; and Sections A(5) and A(6) regarding motivation, obvious to try, and teaching away. App. Br. 18. As stated above, we are not persuaded by these arguments.

The Examiner provides detailed reasons for the rejections of these claims. Ans. 35-37, 52-53.

Appellants' additional arguments are general and not specifically directed to either of claims 69 and 71-73. App. Br. 18-19.

We are therefore not persuaded that the Examiner erred in rejecting claims 69 and 71-73.

Accordingly, we will sustain the Examiner's rejection of claims 69 and 71-73.

CONCLUSIONS

Under § 112, first paragraph, the Examiner erred in rejecting claims 3 and 5. Under § 103, the Examiner did not err in rejecting claims 1-75. Although we have found that the Examiner erred in rejecting claims 3 and 5 under 35 U.S.C. § 112, first paragraph, we have nevertheless found that the Examiner did not err in rejecting those claims under 35 U.S.C. § 103. The rejection of claims 3 and 5 is therefore affirmed.

DECISION

The Examiner's decision rejecting claims 1-75 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

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